

## **REMARKS / ARGUMENTS**

### **I. General Remarks**

Please consider the application in view of the following remarks. Applicants thank the Examiner for her careful consideration of this application.

### **II. Disposition of Claims**

Claims 1-83 are pending in this application.

In this Response, claims 1, 2, 11, 12, 42, 43, 45, 46, 52, 53, 55, 64, 65, 67, 68, 74, 75, and 77 have been amended. These amendments are supported by the specification as filed.

Claims 1-83 stand rejected under 35 U.S.C. § 102(e). Claims 1-83 stand rejected under 35 U.S.C. § 102(a).

### **III. Rejections of Claims**

#### **A. Rejections of Claims Under 35 U.S.C. § 102(e)**

Claims 1-83 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0228985 by Taylor *et al.* (“US2003/0228985”). With respect to these rejections, the Final Office Action states:

US2003/0228985 discloses, with respect to all the claims, a method of treating a subterranean formation comprising: providing a gelled liquid hydrocarbon treatment fluid comprising a liquid hydrocarbon and a gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphinic acid, and treating the subterranean formation with the gelled liquid hydrocarbon treatment fluid. See the entire document, especially paragraphs [0008-0021] and [0023-0057], claims 1-41, and examples 1-12.

(Final Office Action at ¶ 2.) In response to Applicants’ previous arguments regarding these claims, the Final Office Action further states:

Applicant’s arguments filed 9/21/06 have been fully considered but they are not persuasive. Applicant argues that since he claims priority back to February 23, 2001, that neither of the cited references constitute prior art. When, in fact, the instant application is a continuation-in-part of the cited applications and the subject matter of the instant invention is not supported within either application. The subject matter including providing “a gelled liquid hydrocarbon . . . gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphinic acid,” which is the crux of the invention, is new material and is given the benefit of

the filing date of the instant application (1/28/2004). Therefore, the cited references constitute prior art in this application because the new material is not supported by the application with the 2/23/2001 filing date.

(Final Office Action at ¶ 4.) Applicants respectfully disagree with these rejections.

In this Response, Applicants have amended independent claims 1, 42, and 64 (from which all of the remainder of Applicants' claims depend, either directly or indirectly) to require that the gelling agent comprise a polyvalent metal salt of an organophosphonic acid ester. Applicants claim priority from U.S. Patent Application Serial No. 10/409,240, which claims priority from U.S. Patent Application Serial No. 09/792,165 ("the '165 Application"). The '165 Application discloses gelling agents comprising a polyvalent metal salt of an organophosphonic acid ester, and thus supports the full scope of Applicants' claims, as amended herein. The '165 Application was filed on February 23, 2001, which falls on the same date as the earliest effective filing date of *US2003/0228985*. Therefore, *US2003/0228985* does not constitute prior art to Applicants' claims, as amended herein, and Applicants respectfully request the withdrawal of the rejections over this reference.

**B. Rejections of Claims Under 35 U.S.C. § 102(a)**

Claims 1-83 stand rejected under 35 U.S.C. § 102(a) as being anticipated by European Patent Application Publication No. EP 1236863 by Taylor *et al.* ("*EP1236863*"). With respect to these rejections, the Final Office Action states:

EP 1236863 discloses, with respect to all the claims, a method of treating a subterranean formation comprising: providing a gelled liquid hydrocarbon treatment fluid comprising a liquid hydrocarbon and a gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphonic acid, and treating the subterranean formation with the gelled liquid hydrocarbon treatment fluid. See the entire document, especially paragraphs [0001-0035] claims 1-14, and examples 1-10.

(Final Office Action at ¶ 3.) In response to Applicants' previous arguments regarding these claims, the Final Office Action further states:

Applicant's arguments filed 9/21/06 have been fully considered but they are not persuasive. Applicant argues that since he claims priority back to February 23, 2001, that neither of the cited references constitute prior art. When, in fact, the instant application is a continuation-in-part of the cited applications and

the subject matter of the instant invention is not supported within either application. The subject matter including providing “a gelled liquid hydrocarbon . . . gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphinic acid,” which is the crux of the invention, is new material and is given the benefit of the filing date of the instant application (1/28/2004). Therefore, the cited references constitute prior art in this application because the new material is not supported by the application with the 2/23/2001 filing date.

(Final Office Action at ¶ 4.) Applicants respectfully disagree with these rejections.

In this Response, Applicants have amended independent claims 1, 42, and 64 (from which all of the remainder of Applicants’ claims depend, either directly or indirectly) to require that the gelling agent comprise a polyvalent metal salt of an organophosphonic acid ester. Applicants claim priority from U.S. Patent Application Serial No. 10/409,240, which claims priority from U.S. Patent Application Serial No. 09/792,165 (“the ‘165 Application”). The ‘165 Application discloses gelling agents comprising a polyvalent metal salt of an organophosphonic acid ester, and thus supports the full scope of Applicants’ claims, as amended herein. The ‘165 Application was filed on February 23, 2001, which is before the publication date of *EP1236863* (September 4, 2002). Therefore, *EP1236863* does not constitute prior art to Applicants’ claims, as amended herein, and Applicants respectfully request the withdrawal of the rejections over this reference.

#### **IV. No Waiver**

All of Applicants’ arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example arguments sufficient to overcome the Examiner’s § 102(e) and § 102(a) rejections. Other arguments may exist, and Applicants reserve the right to present these additional arguments in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner’s additional statements. The reasons discussed by Applicants are sufficient to overcome the § 102(e) and § 102(a) rejections.

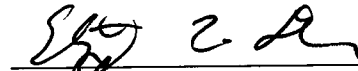
#### **SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Because this response

has been filed within two months of when the Final Office Action was issued, Applicants respectfully request that the Examiner issue an advisory action if the Examiner does not find the claims to be allowable in light of the amendments and remarks made herein. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that there are no fees due in association with this filing of this Response. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.1041, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



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